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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,772	04/02/2004	Daisuke Yahata	360842009711	9959
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
10/17/2008				
EXAMINER				
TENTON, LEO B				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
10/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/815,772

**Applicant(s)**

YAHATA ET AL.

**Examiner**

Leo B. Tentoni

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 August 2008 has been entered.

***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 602.

The application number of the parent application is missing.

***Response to Amendment***

3. The declaration filed on 12 August 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Okawa et al (JP 2002-105752 A) reference.

The submitted declaration has been signed by one inventor, while the instant application lists eight (8) named inventors. A declaration under 37 CFR 1.131 must be signed by all of the named

inventors unless it is shown that less than all of the named inventors of an application invented the subject matter of the claim or claims under rejection (MPEP 715.04(I)).

The submitted declaration also does not show possession of the invention, namely a process of making polylactic acid aliphatic polyester multifilament crimped yarn by crimping drawn multifilament fiber in a crimp-providing apparatus that utilizes heated air at 120 - 170°C. While the submitted declaration shows product properties, the instant invention is directed to a process, unlike the parent application (which was directed to, and claimed, crimped yarn products) (MPEP 715.02).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okawa et al (JP 2002-105752 A) in combination with O'Donnell et al (U.S. Patent 6,770,356 B2).

Okawa et al (see the entire document, in particular, the English-language translation) teaches a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester as claimed, except that Okawa et al does not explicitly teach a two-step drawing process. O'Donnell et al (see the entire document, in particular, col. 1, line 23; col. 2, line 61 to col. 3, line 2; col. 5, lines 52-55; col. 6, lines 37-55) teaches a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester including a two-step drawing process, and such would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Okawa et al in view of O'Donnell et al principally in order to provide fibers that have high elongation at high strain rates and that are thermally stable.

7. Claims 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being obvious over Ochi et al (U.S. Patent 6,761,970 B2) in combination with O'Donnell et al (U.S. Patent 6,770,356 B2).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date

of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(1)(1) and § 706.02(1)(2). Ochi et al (see the entire document, in particular, the examples and tables) teaches a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester as claimed, except that Ochi et al does not explicitly teach a two-step drawing process. O'Donnell et al (see the entire document, in particular, col. 1, line 23; col. 2, line 61 to col. 3, line 2; col. 5, lines 52-55; col. 6, lines 37-55) teaches a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester including a two-step drawing process, and such would have been obvious to one of

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ordinary skill in the art at the time the invention was made in the process of Ochi et al in view of O'Donnell et al principally in order to provide fibers that have high elongation at high strain rates and that are thermally stable.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 25 and 27-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 21 of U.S. Patent No. 6,761,970 B2 (Ochi et al) in view of O'Donnell et al (U.S. Patent 6,770,356 B2). Claim 21 of Ochi et al recites a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester as claimed, except that Ochi et al does not explicitly

claim a two-step drawing process (note that portions of the specification which provide support for claim 21 may also be examined and considered when addressing the issue of obviousness-type double patenting; see MPEP 804(II)(B)(1)). O'Donnell et al (see the entire document, in particular, col. 1, line 23; col. 2, line 61 to col. 3, line 2; col. 5, lines 52-55; col. 6, lines 37-55) teaches a process of making a multifilament crimped yarn from a polylactic acid aliphatic polyester including a two-step drawing process, and such would have been obvious to one of ordinary skill in the art at the time the invention was made in the process of Ochi et al in view of O'Donnell et al principally in order to provide fibers that have high elongation at high strain rates and that are thermally stable.

#### ***Response to Arguments***

10. Applicant's arguments filed on 12 August 2008 have been fully considered but they are not persuasive.
11. The declaration under 37 CFR 1.131 submitted on 12 August 2008 has been considered (see above).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (571) 272-1209. The examiner can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can



be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Leo B. Tentoni/  
Primary Examiner, Art Unit 1791